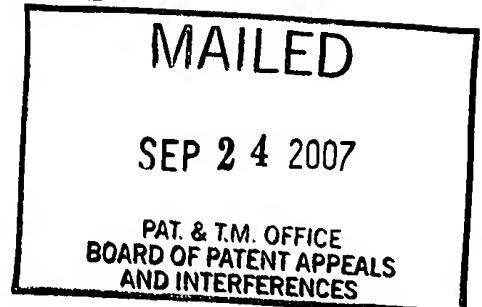


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK HOWARD

Application No. 10/604,830



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on September 14, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

APPEAL BRIEF

Summary Of Claimed Subject Matter

Appellant filed an Appeal Brief dated November 1, 2005, in response to the Final Rejection mailed August 17, 2005. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

§ 37 CFR § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

* * *

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

Section 37 CFR§ 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

In addition, the Appeal Brief filed on November 11, 2005, on page 11, under the heading "Grounds of Rejection to be Reviewed on Appeal (VI)" the Appellants stated:

- A. Applicant appeals the rejections of claims 1 and 5 under 35 U.S.C. § 102(b) as being anticipated by Tsiounis.
- B. Applicant appeals the rejection of claim 11 under U.S.C. § 103(a) as being unpatentable over Tsiounis in view of Barlow.
- C. Applicant appeals the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Tsiounis in view of Barlow.
- D. Applicant appeals the rejections of claims 13 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Barlow.

In response, an Examiner's Answer was mailed on January 18, 2006. While the Answer notes that "the appellant's statement of the grounds of rejection to be reviewed on appeal is correct" [2], the Examiner's Answer and the Final Rejection

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mailed November 17, 2005, the following § 103 rejections were made:

Claims 1-6 are rejection under U.S.C. 102(b) as being anticipated by Tsiounis et al. U.S. Patent Application Publication No.: US 2001/0039535 A1.

Claims 7-11 are rejected under U.S.C. 103(a) as being unpatentable over Tsiounis et al., U.S. Patent Application Publication No.: US 2001/0039535 A1 in view of Barlow et al., U.S. Patent 6,038,551.

Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U.S. Patent 6,038,551.

A clarification of the claims to be applied in the rejection is required.

EXAMINER'S ANSWER

Evidence Relied Upon

The Examiner's Answer mailed January 18, 2006, is defective. The appendix heading "Evidence Relied Upon" (section [8,] pg.[3]) the Examiner indicates "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal." In accordance with MPEP § 1207.02, the "Evidence Relied Upon" (section 8) should include:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

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Correction of the record is required, the Examiner may issue a PTOL-90 to identify the evidence relied upon in the rejection of the appealed claim.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief of November 1, 2005 defective;
- 2) notify appellant to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 4) to give a proper explanation of the grounds of rejection;

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- 5) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer: and
- 6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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